

## **REMARKS**

### **I. Introduction**

Claims 100 to 106 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 100 to 103 Under 35 U.S.C. § 103(a)**

Claims 100 to 103 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,609,285 ("Grant et al.") and U.S. Patent No. 6,162,236 ("Osada"). It is respectfully submitted that the combination of Grant et al. and Osada does not render unpatentable these claims for at least the following reasons.

Claim 103 recites inter alia, that at least a portion of a trocar shaft that is extendable distally relative to a clamping face at a distal end of a housing and that is extendable between the clamping face and the anvil is flexible. The Office Action admits that Grant et al. does not disclose this feature but asserts that "[i]t would have been obvious to one having ordinary skill in the art at the time of the invention to modify the trocar shaft of Grant to be flexible, since Osada suggests that such a modification allows a trocar to be easily passed through the trocar shaft." Office Action, page 3.

Contrary to the assertion of the Office Action, there is no indication that the shaft 41 of Osada is flexible. Thus, neither of Grant et al. and Osada discloses or suggests that at least a portion of a trocar shaft that is extendable distally relative to a clamping face at the distal end of a housing and that is extendable between the clamping face and an anvil is flexible. As such, the combination of Grant et al. and Osada does not disclose or suggest all of the features of claim 100.

Furthermore, the Office Action fails to adequately set forth a prima facie case of obviousness consistent with the Supreme Court's KSR decision, i.e., KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007), to modify the structure of Grant et al. between, e.g., elements 103 and 105 of Figure 7 to include the features of Osada. In this regard, the elements of Osada are provided to allow a tube through which a trocar and/or surgical instruments are passed to expand from a tapered arrangement to a cylindrical arrangement after being inserted into an incision location. The expansion of the tube supports and

widens the opening in the flesh. There is no apparent reason whatsoever why one of ordinary skill in the art would utilize the features of Osada at a location between a clamping face and an anvil of a stapler. Indeed, this portion is not intended to support any opening in the tissue, which is the only apparent purpose of the expandable structure of Osada. To the contrary, clearance is required in this region to allow for the tissue that is to be stapled by closing the anvil and the clamping face.

In view of the foregoing, it is respectfully submitted that the combination of Grant et al. and Osada does not render unpatentable claim 100 or claims 102 and 103, which ultimately depend from claim 100. Accordingly, withdrawal of this rejection is respectfully requested.

### **III. Rejection of Claims 104 to 106 Under 35 U.S.C. § 103(a)**

Claims 104 to 106 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Grant et al., Osada, and U.S. Patent No. 6,491,201 ("Whitman"). It is respectfully submitted that the combination of Grant et al., Osada, and Whitman does not render unpatentable these claims for at least the following reasons.

Claims 104 to 106 ultimately depend from claim 100 and therefore include all of the features recited in claim 100. As more fully set forth above, the combination of Grant et al. and Osada does not disclose or suggest all of the features of claim 100. Whitman is not relied upon for disclosing or suggesting the features of claim 100 not disclosed or suggested by the combination of Grant et al. and Osada.

In view of the foregoing, it is respectfully submitted that the combination of Grant et al., Osada, and Whitman does not disclose or suggest all of the features of the present claims. As such, it is respectfully submitted that the combination of Grant et al., Osada, and Whitman does not render unpatentable the present claims. Accordingly, withdrawal of the present rejection is respectfully requested.

#### IV. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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